

Applicant: Tchao, Ruy  
Application Serial No.: 09/472,490  
Filing Date: December 23, 1999  
Docket No.: 102-302 RES/CON  
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### **REMARKS**

The Examiner's final rejection of the application dated March 30, 2001, was appealed to the Board of Patent Appeals and Interferences. In response to Appellant's Brief, prosecution was reopened. The reopening of prosecution did not result in allowable subject matter. This necessitated reopening of the appeal. The reopening of the appeal and the refiling of the Appeal Brief resulted in the present non-final Office Action being issued by the Examiner.

In the present Office Action, claims 46-50 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-15 and 38-41 of copending Application Serial No. 09/966,831. While the claims of the copending application have been allowed, a patent has not issued. Therefore, the present rejection is a provisional double patenting rejection. Upon issuance of the patent, a timely terminal disclaimer will be filed in the present application. Reconsideration is respectfully requested.

The Examiner has required a supplemental oath or declaration complying with 37 C.F.R. §1.63 and 1.175. Upon an indication of allowable subject matter, applicant will provide an appropriate supplemental oath or declaration. Reconsideration is respectfully requested.

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The Examiner has indicated that claim 49 includes allowable subject matter. This determination is gratefully acknowledged.

The Examiner has rejected claims 46-48 and 50 under 35 U.S.C. §112, first paragraph, stating that while the specification is enabling for nondestructive chemotaxis assays, the specification does not provide enablement for any and all types of nondestructive assays. Moreover, claims 46-48 and 50 are rejected under 35 U.S.C. §251 as being improperly broadened in a reissue application. Each of these determinations are respectfully traversed.

Undersigned counsel has addressed each of these issues in the Appeal Brief dated December 26, 2001, as well as in the reopened Appeal Brief dated November 7, 2003. The Examiner is referred to the arguments presented in these Briefs with respect to the rejections under §112 and §251. In light of these arguments, reconsideration of the rejection is respectfully requested.

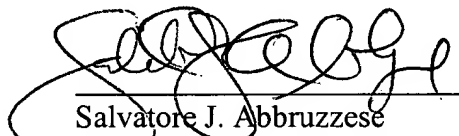
For the Examiner's assistance, a copy of the most recently filed Appeal Brief mailed November 7, 2003 is enclosed. The Examiner's attention is referred to the arguments presented therein.

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It is respectfully submitted that the arguments presented in the Appeal Brief overcome the Examiner's rejections. Accordingly, the application is deemed to be in condition for allowance. Favorable action thereon is respectfully solicited.

Should the Examiner have any questions or comments concerning the above, the Examiner is respectfully invited to contact the undersigned attorney at the telephone number given below.

Respectfully submitted,

  
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